

REMARKS

Claims 27-35 are currently pending and under examination.

Priority

The present application claims priority to U.S. Patent Application No. 08/215,030 (hereinafter, “the priority application”), filed March 18, 1994. The Examiner asserts that the priority application fails to provide adequate support or enablement as required by 35 U.S.C. § 112, for one or more claims of the present application, and therefore fails to comply with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120. Specifically, the Examiner asserts the priority application lacks adequate support for a method of delivering one or more biologically active factors comprising administering to a human or animal a composition comprising more than one biologically-active factor and a target molecule admixed with or bound to a colloidal metal.

In the rejection of claims 27-35 under 35 U.S.C. § 102(b) discussed below, the Examiner asserts that the presently claimed invention is anticipated by WO 1994/21288 (hereinafter, “the ‘288 application”) as evidence by Van Den Pol (Quarterly Journal of Experimental Physiol. 1984, 69:1-33), the NCBI MeSH entry for TNF-alpha, and WO 95/249118.

The ‘288 application shares the same filing date as the priority application, March 18, 1994. The ‘288 application claims priority to U.S. Patent Application No. 08/033,385 (hereinafter, “the ‘385 application”). The priority application is a continuation of the ‘385 application. As can be expected, there is a tremendous degree of similarity between the disclosure of the ‘288 application and that of the priority application.

The Examiner points to multiple sections of the ‘288 application in support of his rejection under 35 U.S.C. § 102(b). The following table shows where the exact disclosure cited by the Examiner in the ‘288 application can also be found in the priority application.

TABLE I

<u>Disclosure</u>	<u>The '288 application</u>	<u>The priority application</u>
use of combinations of biologically-active factors	abstract	abstract
use of colloidal metals in combination with biologically-active factors	page 6, lines 23-21	page 14, line 30 - page 15, line 12
use of IL-12 and Tumor Necrosis Factor	page 5, lines 17-28 and claim 4	page 13, lines 7-30 and claim 4
IL-1 when mixed with colloidal gold retains biological activity	Example VI and Figure 2	Example 6 and Figure 4
IL-6 efficiently binds colloidal gold	Example VII	Example 7

For the '288 application to qualify as a valid prior art reference under 35 U.S.C. § 102(b) it must contain an enabling disclosure¹. It is the Applicants understanding that the Examiner considers the disclosure of the '288 application sufficient to establish anticipation and therefore enabling. Given that the exact disclosure found in the '288 application can also be found in the priority application, it follows that the priority application must also be considered to contain an enabling disclosure consistent with the requirements of 35 U.S.C. § 112. Applicants note that the Examiner also relies on Van Den Pol, the NCBI MeSH database, and WO 95/249118 in support of the rejection under 35 U.S.C. § 102(b). However, these references merely demonstrate what was well known in the art at the time of filing of both the '288 application and the priority application. It is not necessary for the priority application to disclose what was well known in the art in order to satisfy the requirements under 35 U.S.C. § 112².

For at least the foregoing, Applicants submit the presently claimed invention is entitled to the benefit of the filing date of the priority application and respectfully request that the Examiner

¹ *In re Hoeksema*, 399 F.2d 269 (CCPA 1968); See also MPEP 2121.01

² *In re Buchner*, 929 F.2d 660, 661 (*Fed. Cir.* 1991)

acknowledge the filing date of the priority application as the present application's effective filing date.

Claim Rejections - 35 U.S.C. § 102(b)

In the Non-Final Rejection mailed April 15, 2009, the Examiner maintained the rejection of claims 27-35 under 35 U.S.C. § 102(b) as anticipated by the '288 application as evidenced by Van Den Pol, the NCBI MeSH database, and WO 95/249118.

A published patent application is prior art under 35 U.S.C. § 102(b) as of its publication date. The publication date of the '288 application is September 29, 2004. As discussed above, the present application is entitled to the benefit of the filing date of U.S. Patent Application No. 08/215,030, filed March 18, 1994. Therefore, the '288 application is not a valid reference under 35 U.S.C. § 102(b). Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the '288 application as a reference under 35 U.S.C. § 102(b).

CONCLUSION

The foregoing is submitted as a full and complete response to the Non-Final Office Action mailed April 15, 2009, and early and favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application that may be corrected by Examiner's amendment, or there are any other issues which can be resolved by telephone interview, a telephone call to the undersigned agent at (404) 572-2447 is respectfully solicited.

No further fees are believed to be due in connection with this response. However, the Commissioner is hereby authorized to charge any underpayment or credit any overpayment of fees to Deposit Account No. 11-0980.

Respectfully submitted,

/F. BRENT NIX/

F. Brent Nix

Reg. No. 59,004

KING & SPALDING LLP
1180 Peachtree Street, N.E.
Atlanta, Georgia 30309-3521
Telephone (404) 572-4600
Facsimile (404) 572-5134